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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR      | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|---------------------------|---------------------|------------------|
| 10/617,528  | 07/10/2003  | Nigel Howard Julian Brown | AUS920030295US1     | 3557             |
| 35525   | 7590        | 09/18/2008                |                     |                  |
| IBM CORP (YA)<br>C/O YEE & ASSOCIATES PC<br>P.O. BOX 802333<br>DALLAS, TX 75380 |             |                           |                     |                  |
| EXAMINER  |             |                           |                     |                  |
| KARDOS, NEIL R  |             |                           |                     |                  |
| ART UNIT  |             | PAPER NUMBER              |                     |                  |
| 3623  |             |                           |                     |                  |
| NOTIFICATION DATE   |             | DELIVERY MODE             |                     |                  |
| 09/18/2008  |             | ELECTRONIC                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeciipaw.com

# Office Action Summary

**Application No.**

10/617,528

**Applicant(s)**

BROWN ET AL.

**Examiner**

Neil R. Kardos

**Art Unit**

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is a **FINAL** Office action on the merits in response to communications filed June 25, 2008. Claims 1, 5, and 8 have been amended. Claims 9-20 have been cancelled. Currently, claims 1-8 are pending and have been examined.

***Response to Arguments***

2. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejection, found below, is necessitated by Applicant's amendments. Thus, the finality of the Office action is proper.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 3-4, and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie (US 2005/0043985).**

Claim 1: Gillespie discloses a method in a data processing system for providing a consulting assessment environment, the method comprising:

- receiving data about a business through a questionnaire, wherein the questionnaire is defined by a data template (see paragraph 36: lines 10-23, disclosing a survey

system to present questions and receive responses regarding a business; paragraph 37, disclosing customizing the survey questions);

- computing at least one assessment score based on formulas in an assessment framework template (see paragraph 38: lines 1-15, disclosing evaluating responses and generating a score based on the responses; paragraphs 43-51, disclosing specific calculations)
- determining an appropriate action based on the at least one assessment score and a suggested actions template (see paragraph 38: lines 8-15, disclosing providing the user with a recommendation; paragraph 43); and
- reporting results based on the at least one assessment score and the appropriate action in accordance with a report template, wherein the assessment framework template and the suggested actions template encode business-related domain knowledge (see paragraph 38: lines 8-30, disclosing reporting results to users; paragraph 52; paragraph 56) including at least one of best practices, business consultant expertise, and business goals (see paragraph 37: disclosing customizing a survey and evaluation based on an administrator's input).

Gillespie does not explicitly disclose wherein proprietary information and trade secrets of the consulting assessment environment are hidden from clients. However, Gillespie does teach limiting data access to authorized users (see ¶¶ 38, 56-57, and 82).

Examiner takes Official Notice that it was well-known in the arts at the time the invention was made to limit access to confidential data. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to hide confidential data from

clients when performing the method of Gillespie. One of ordinary skill in the art would have been motivated to do so for the benefit of increased security.

Claim 3: Gillespie discloses identifying benefits and risks based on the at least one assessment score and the appropriate action (see paragraphs 39, 52, and 56, disclosing determining the merits and costs; paragraph 54).

Claim 4: Gillespie discloses consolidating portions of the results together for further analysis (see paragraph 38; lines 15-19; paragraphs 42 and 54).

Claim 6: Gillespie discloses wherein the data template includes at least one of interview questions (see paragraph 37), weighing factors (see paragraph 37), desired states, benefit descriptions (see paragraph 54), risk descriptions, suggested actions (see paragraph 42), cost areas (see paragraph 54), and terminology.

Claim 7: Gillespie discloses wherein the assessment framework template includes at least one of scoring information (see paragraphs 43-51), calculations (see id.), suggested actions logic (see id.), benefit and risk logic (see id.), user feedback (see id.), and user input (see id.).

Claim 8: Gillespie does not explicitly disclose wherein the proprietary information and the trade secrets of the consulting assessment environment that are encoded in any of the data template, the assessment framework template, the suggested actions template, and the report

template are made inaccessible to the clients. However, Gillespie does teach limiting data access to authorized users (see ¶¶ 37-38, 56-57, and 82).

Examiner takes Official Notice that it was well-known in the arts at the time the invention was made to limit access to confidential data. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to hide confidential data from clients when performing the method of Gillespie. One of ordinary skill in the art would have been motivated to do so for the benefit of increased security.

**5. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie in view of Griffor (US 2002/0173999).**

Claim 2: Gillespie does not explicitly disclose:

- determining a current state of the business based on the data;
- identifying a desired state for the business using the assessment framework template and the suggested actions template; and
- performing a gap analysis between the current state of the business and the desired state of the business to determine the appropriate action to achieve the desired state for the business.

Griffor teaches bringing the current state of a business into alignment with its goals and purposes via a consulting process that determines appropriate actions required for that alignment (see paragraphs 15-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teachings of Griffor to the invention of Gillespie in order to take actions

that would align a business with its goals. One of ordinary skill in the art would have been motivated to do so for the benefit of more efficient management of opportunities (see Gillespie, paragraph 1).

Claim 5: Gillespie discloses providing an interface for a client to conduct a self-assessment (see paragraph 36: lines 31-34).

Gillespie does not explicitly disclose gathering data about the business, wherein the data is used to determine a current state of the business, and wherein automated data synthesis is performed to relate the current state of the business to a desired state in real time.

Griffor teaches brining the current state of a business into alignment with its goal and purposes via a consulting process that determines appropriate actions required for that alignment (see paragraphs 15-19)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teachings of Griffor to the invention of Gillespie in order to take actions that would align a business with its goals. One of ordinary skill in the art would have been motivated to do so for the benefit of more efficient management of opportunities (see Gillespie, paragraph 1).

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos  
Examiner  
Art Unit 3623

NRK  
9/9/08  
/Jonathan G. Sterrett/  
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